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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,292	07/08/2003	Steven Hartman	14391	7384

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Ralph A. Dowell of DOWELL & DOWELL P.C.  
2111 Eisenhower Ave  
Suite 406  
Alexandria, VA 22314

EXAMINER

EASHOO, MARK

ART UNIT PAPER NUMBER

1732

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/614,292

Applicant(s)

HARTMAN, STEVEN

Examiner

Mark Eashoo, Ph.D.

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of claim group I, claims 1-8, in the reply filed on 03-NOV-2005 is acknowledged. The traversal is on the ground(s) that the claims of group II depend from group I and therefore should be considered together. This is not found persuasive because it is well established that the writing of claims in dependent form is merely a short-hand method of writing a separate claim. Applicant correctly states that the claims of group II are direct to products formed by the process of claims in group I, and as such are considered, product-by-process claims which the courts have held are "product claims" of which patentability is based upon the structure of the product and not the process.

The requirement is still deemed proper and is therefore made FINAL.

Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected claim groupings, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 03-NOV-2005.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Knaus (US Pat. 4,919,864).

Regarding claim 1: Knaus teaches the claimed process of forming an extruded foam article comprising: extruding a first foam material through an extrusion channel wherein the first foam material has an outer surface within the extrusion channel (Figs. 1-3); and applying a visible first coating onto the outer surface of the first foam material wherein the coating only occupies a fraction of the perimeter of the outer surface (Figs. 1, 3, 4 and element 82).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knaus (US Pat. 4,919,864) in view of Johnson (US Pat. 2,191,829).

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Knaus teaches the basic claimed process of forming an extruded foam article comprising: extruding a first foam material through an extrusion channel wherein the first foam material has an outer surface within the extrusion channel (Figs. 1-3); and applying a visible first coating onto the outer surface of the first foam material wherein the coating only occupies a fraction of the perimeter of the outer surface (Figs. 1, 3, 4 and element 82).

Regarding claim 2: Knaus does not teach rotating an applicator/die portion to form a helical band, but does that the colored material may have a multitude of patterns (2:35-40). Nonetheless, Johnson teaches forming a helical band on an extrudate by rotating an applicator/die portion (Figs. 4-6 and 2:1-55). It is noted that the rotation of die portion is parallel to the axis of extrusion. Knaus and Johnson are combinable because they are from the same field of endeavor, namely, coextrusion and the forming of a striped extrudate. At the time of invention a person of ordinary skill in the art would have found it obvious to have formed a helical band on an extrudate by rotating an applicator/die portion, as taught by Johnson, in the process of Knaus, and would have been motivated to do so because Johnson suggests that such helical bands provide desirable ornamentation to the extrudate.

Regarding claims 3-4: Knaus does not teach an applicator/die portion forming part of the extrusion channel and having a plurality of spaced flows. Nonetheless, Johnson teaches an applicator/die portion forming part of the extrusion channel and having a plurality of spaced flows (Figs. 4-6 and 2:1-55). At the time of invention a person of ordinary skill in the art would have found it obvious to have used an applicator/die portion forming part of the extrusion channel and having a plurality of spaced flows, as taught by Johnson, in the process of Knaus, and would have been motivated to do so because Johnson suggests that such applicator/die portion is an equivalent means to provide material flows streams to form stripes on an extrudate.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knaus (US Pat. 4,919,864) in view of Johnson (US Pat. 2,191,829) as applied to claims 2-4 above, and further in view of Puchert (CH 675982 A5).

Regarding claim 5: Knaus teaches the basic claimed process as set forth above. Knaus does not teach an applicator/die portion for forming multiple helical colored bands, but does that the colored material may have a multitude of patterns (2:35-40). Nonetheless, Puchert teaches an applicator/die portion for forming multiple helical colored bands (Figs. 1, 2, and 7). Knaus and Puchert are combinable because they are from the same field of endeavor, namely, coextrusion and the forming of a striped extrudate. At the time of invention a person of ordinary skill in the art would have found it obvious to have formed multiple colored helical bands on an extrudate by rotating an applicator/die portion, as taught by Puchert, in the process of Knaus, and would have been motivated to do so because Johnson suggests that such helical bands provide desirable ornamentation to the extrudate.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knaus (US Pat. 4,919,864).

Knaus teaches the basic claimed process of forming an extruded foam article comprising: extruding a first foam material through an extrusion channel wherein the first foam material has an outer surface within the extrusion channel (Figs. 1-3); and applying a visible first coating onto the outer surface of the first foam material wherein the coating only occupies a fraction of the perimeter of the outer surface (Figs. 1, 3, 4 and element 82).

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Regarding claims 6-8: Knaus further teaches expanding the first foamable thermoplastic material and coating to about 4 times (2:4-34 and 5:29-42).

Knaus does not teach expanding the foamable thermoplastic material by a factor of 10-50 times. Nonetheless, expansion ratios of foamable thermoplastics on the order of 10-50 times are well known in the molding art and are dependent upon the amount of blowing agent used and the foam cell size desired. At the time of invention a person of ordinary skill in the art would have found it obvious to have expanded a foamable thermoplastic material by a factor of 10-50 times, as commonly practiced in the art, in the process of Knaus, and would have been motivated to do so in order to form a desirable light weight foamed extrudate.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Eashoo, Ph.D.  
Primary Examiner  
Art Unit 1732

20/Jan/06

January 20, 2006  
me